

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of : NAKAJIMA et al.

Application No. : 10/049,438 Art Unit: 1713

Filed : May 30, 2002 Examiner: LEE, Rip A.

Confirmation No. : 3695

Docket No. : 11197/7 Customer No.: 23838

For : A POLYESTER POLYMERIZATION CATALYST,
POLYESTER PRODUCED BY USING THE SAME,
AND A PROCESS FOR PRODUCING POLYESTER

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Sir:

In response to the Notice of Allowability mailed November 29, 2006, applicants herein submit comments regarding the Statement of Reasons for Allowance and the Examiner's Amendment.

Comments on the Statement of Reasons for Allowance

In discussing Jackson et al. (US 3,847,873), the Examiner made a statement: "a phosphorus compound of formula $X^1X^2(X^3O)P=O$ wherein at least one R group attached to Z is biphenyl" which contains typographical errors. To be consistent with the disclosures of Jackson et al., it appears that the Examiner intended to state that "a phosphorus compound of formula $X^1X^2(X^3O)P=O$, wherein X^1 is -R or -OR, X^2 is -R, X^3 is H or -R, and at least one R group attached to P is biphenyl."

Comments on the Examiner's Amendment

In the Notice of Allowability, Examiner Lee amended each of claims 37-39, 43 and 44 in the same ways. The comments of applicants apply to the Examiner's Amendment to each of claims 37-39, 43 and 44. In providing the comments, applicants use the amendments to claim 37 as exemplary. Claim 37 was amended by the Examiner as follows:

37. (after the Examiner's Amendment) The process of claim 9, wherein the aluminum carboxylates are selected from aluminum formate, aluminum acetate, aluminum propionate, aluminum oxalate, aluminum acrylate, aluminum laurate, aluminum stearate, aluminum benzoate, aluminum trichloroacetate, aluminum lactate, aluminum citrate, and or aluminum salicylate, wherein the aluminum salts of an inorganic acid are selected from aluminum chloride, ~~aluminum hydroxide~~, aluminum hydroxide chloride, aluminum carbonate, aluminum phosphate and or aluminum phosphonate, and wherein the aluminum chelate compounds are selected from aluminum acetylacetonate, aluminum acetylacetate, aluminum ethyl acetoacetate, and or aluminum ethyl acetoacetate di-isopropoxide.

Applicants respectfully disagree with the replacement of "and" with "or" in lines 5, 7 and 9 of any one of claims 37-39, 43 and 44. The replacements concern Markush groups recited in the claims. The Examiner's Amendment is akin to amending a hypothetical Markush group: "Xs are selected from A, B, C **and** D" to read "Xs are selected from A, B, C **or** D" (emphasis added). Applicants contend that "Xs are selected from A, B, C **and** D" is a proper alternative to the classical Markush group language of "Xs are **selected from the group consisting of** A, B, C **and** D." Applicants note that, according to customary English usage, "selected from" generally precedes a list or plural term.

Examples of writing in which the phrase "selected from" precedes a list, wherein the list presents its members with the conjunction "and" immediately preceding the last member can be found in both technical and general publications (with emphasis added below):

(1) *Ceramic Composites Having a Weak Bond Material **Selected from Monazites and Xenotimes***, in *Composites Part A: Applied Science and Manufacturing (Incorporating Composites and Composites Manufacturing)*, Volume 27, Number 11, 1996, page 1119, published by Elsevier Science;

(2) *Phenotypic Characterization of Quinolone-Resistant Mutants of Enterobacteriaceae **Selected from Wild Type, gyrA Type and Multiplyresistant (marA) Type Strains***, *Journal of Antimicrobial Chemotherapy*, Volume 28, Number 2, pp. 185-198, 1991; and

(3) *Paul Klee, His Life and Work in Documents: **Selected from Posthumous Writings and Unpublished Letters***, a book by Felix, Klee, translated by Clara and Richard Winston, published by George Braziller, New York, 1962.

In other words, the recitation “wherein the aluminum carboxylates are **selected from** aluminum formate, aluminum acetate, aluminum propionate, aluminum oxalate, aluminum acrylate, aluminum laurate, aluminum stearate, aluminum benzoate, aluminum trichloroacetate, aluminum lactate, aluminum citrate, **and** aluminum salicylate” in each of claims 37-39, 43 and 44 before the Examiner’s Amendment is a proper expression, meaning that the “aluminum carboxylates” are selected from the list that follows.

In a telephone interview with Examiner Lee conducted by the undersigned on December 8, 2006, Examiner Lee indicated that, when he prepared the Examiner’s Amendment, he considered the hypothetical expression, “Xs are selected from A, B, C and or D,” to have the same meaning as the classical Markush group language, “Xs are selected from the group consisting of A, B, C and D.” Using the recitation concerning “aluminum carboxylates” as an example, Examiner Lee interpreted the recitation “wherein the aluminum carboxylates are **selected from** aluminum formate, aluminum acetate, aluminum propionate, aluminum oxalate, aluminum acrylate, aluminum laurate, aluminum stearate, aluminum benzoate, aluminum trichloroacetate, aluminum lactate, aluminum citrate, **and or** aluminum salicylate” obtained via the Examiner’s Amendment in each of claims 37-39, 43 and 44 to be of the same scope as “wherein the aluminum carboxylates are **selected from the group consisting of** aluminum formate, aluminum acetate, aluminum propionate, aluminum oxalate, aluminum acrylate, aluminum laurate,

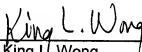
aluminum stearate, aluminum benzoate, aluminum trichloroacetate, aluminum lactate, aluminum citrate, **and** aluminum salicylate" (emphasis added). As a result, with the replacement of "and" with "or" in claims 37-39, 43 and 44, the Examiner interpreted these claims by treating his version of the Markush groups in the format of "Xs are selected from A, B, C or D" to have the same scope as the classical Markush groups in the format of "Xs are selected from the group consisting of A, B, C and D." Thus, claims 37-39, 43 and 44 should be interpreted accordingly.

The Commissioner is authorized to charge any fees that may be required in relation to the filing of this paper to Deposit Account No. 11-0600.

Respectfully submitted,

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Date: February 22, 2007



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